

REMARKS

Claims 1-12 are currently pending in this application. Claims 5-10 were withdrawn from further consideration.

SPECIFICATION:

The Examiner objected to the amendments (submitted on July 21, 2003) under 35 U.S.C. §132 because they allegedly introduce new matter. In particular, the Examiner alleges that the phrase "contained in" that was added to claims 1, 2 and 4 is not supported by the specification.

In the Advisory Action dated February 20, 2004, the Examiner responds to Applicant's Response dated December 22, 2003, by stating that "there is insufficient and contradicting evidence toward the new matter rejection."

Applicant respectfully notes that it is well settled that new matter is that which is not found in the specification or drawings as first filed and which involves a departure from the original invention. In other words, new matter is material which is not explicitly, implicitly, inherently or intrinsically present in a patent application as of its effective filing date. See *In re Oda*, 170 U.S.P.Q. 268 (C.C.P.A. 1971). The standard for determining the presence of new matter does not require a threshold level of "evidence" as the Examiner appears to assert. Instead, a determination must be made as to whether the matter was explicitly, implicitly, inherently or intrinsically present in a patent application as of its effective filing date.

In this case, the recitation of “CCA particles which are contained in the mother particles,” as in claim 1 was explicitly present in the specification as originally filed, as well as the drawings.

The following are specific portions of the disclosure that support the claimed features:

1) First line on page 18 describes the charge controlling agent particles 19 (CCA) as being “contained in” mother particles 18.

2) Figure 2b shows the CCA 19 contained in the mother particles 18. As one skilled in the art would appreciate, the use of broken lines represents an element which is contained within another element.

3) The last full paragraph on page 30 describes mother particles 18 as having a plurality of additive particles 19 “entrapped therein.”

4) Figure 9 again shows the CCA 19 contained in the mother particles 18 through the use of broken lines.

Accordingly, Applicant respectfully submits that the amendments made on July 21, 2003, did not introduce new matter because they are fully supported by the specification. Therefore, withdrawal of the objection is respectfully requested.

35 U.S.C. §112:

Claims 1-4, 11 and 12 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Similar to above, the Examiner alleges that there is no support for a CCA particle “contained in” a mother particle. Applicant respectfully submits that, as noted above, support for the claims is found in the specification. Therefore, the specification would have reasonably conveyed to one skilled in the art that the Applicant, at the time the application was filed, had possession of the claimed invention. Accordingly, withdrawal of the rejection under 35 U.S.C. §112, first paragraph, is respectfully requested.

35 U.S.C. §103:

Claims 1-4, 11 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Oshiba (U.S. Patent Publication No. 2002/0110746). Applicant respectfully traverses this rejection in view of the following remarks.

As a preliminary matter Applicant submits that, in accordance with MPEP §707.07(f), “where Applicant traverses any rejection, the examiner, should, if he or she repeats the rejection, take note of the Applicant’s argument and answer the substance of it.” Since the Examiner has not withdrawn the rejection, Applicant requests the Examiner to provide an explanation as to how the alleged CCA of Oshiba would have taught all of the presently claimed features.

Applicant submits that Oshiba fails to teach or suggest the claimed features. Generally, in non-magnetic mono-component toner, a CCA is contained in toner mother particles to improve the charge characteristic of the toner mother particles. However, a problem occurs in that as too much CCA is contained in the toner mother particles, the charge of each particle of the toner mother particles becomes too large, leading to a decrease in development effectiveness.

To avoid this problem, in an illustrative, non-limiting embodiment of the non-magnetic mono-component toner of claims 1 and 4, the following inventive equation is included:

$$a \times d < 2.5$$

wherein “a” is the inclination of an approximation straight line of the CCA particles contained in the mother particles, obtained by approximating distribution of particle diameter of the CCA particles relative to the particle diameter of the mother particles by the least-square method, and “d” (μm) is the volume-based mean particle diameter of the toner. According to this feature, the amount of the CCA to be contained in each particle of the toner mother particles in the illustrative embodiment is controlled to be small, thereby effectively holding down the charge of each particle of the toner.

In contradistinction, the toner of Oshiba contains an amount of not less than 0.1% by mass of a CCA in which the isolation ratio of the CCA is not more than 10% by number. Oshiba provides a particular definition for the isolation ratio, which reads:

“The ‘isolation ratio’ of the specified element is a ratio (% by number) of the number of the particles containing the specified element other than the colored particle, for example, particles of the magnetic substance and the charge controlling agent, to the whole number of particles of the toner.”

Paragraph 22 of Oshiba.

That is, the toner disclosed in Oshiba teaches one to reduce the amount of CCA isolated (liberated) from toner mother particles in order to inhibit the change in the charging property of toner caused by isolated CCA of more than 10% by number. However, this does not teach or suggest the claimed non-magnetic mono-component toner that satisfies a $\alpha d < 2.5$ wherein “a” is the inclination of an approximation straight line of said CCA particles contained in said mother particles and “d” (μm) is the volume-based mean particle diameter of said toner. Such particular features result in beneficial aspects that contribute to the art.

Accordingly, Applicant submits that the features of claims 1 and 4 are not obvious in light of Oshiba. Likewise, the features of dependent claims 2, 3, 11 and 12 are not obvious by virtue of their respective dependencies and their individual recitations. Thus, the rejection of these claims under 35 U.S.C. §103(a) as being unpatentable over Oshiba should be withdrawn.

In view of the preceding remarks, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue that the Examiner feels may be best resolved through a personal or telephonic interview, he is kindly requested to contact the undersigned attorney at the local telephone number listed below.

REPLY UNDER 37 C.F.R. §1.114
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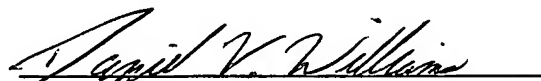
Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER


Daniel V. Williams
Registration No. 45,221

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